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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09-976,472	10-11-2001	John E. Sims	2932-B	9942

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IMMUNEX CORPORATION
LAW DEPARTMENT
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EXAMINER

ANDRES, JANET L

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 11-20-2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,472

Applicant(s)

SIMS ET AL.

Examiner

Janet L. Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to polynucleotides and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- II. Claims 11-14, drawn to polypeptides, classified in class 530, subclass 351.
- III. Claim 15, drawn to antibodies, classified in class 530, subclasses 388.1 and 389.1.
- IV. Claims 16 and 17, drawn to methods of screening, classified in class 435, subclass 7.1.
- V. Claims 18 and 19, drawn to antagonists, classified in class 530, subclass 300.
- VI. Claims 20-23, drawn to methods of treatment, classified in class 514, subclass 2.

The Examiner notes that claim 21 appears to be a duplicate of claim 20.

The inventions are distinct, each from the other because of the following reasons:

The polynucleotides of Invention I are not related to the polypeptides of Invention II.

They differ structurally and functionally, cannot be used together or interchangeably, and have non-coextensive searches and considerations.

The polynucleotides of Invention I are not related to the antibodies of Invention III. They differ structurally and functionally, cannot be used together or interchangeably, and have non-coextensive searches and considerations.

The polynucleotides of I are not related to the methods of Invention IV. They cannot be used in these methods.

The polynucleotides of Invention I are not related to the antagonists of Invention V. They differ structurally and functionally, cannot be used together or interchangeably, and have non-coextensive searches and considerations.

The polynucleotides of Invention I are not related to the methods of Invention VI. They cannot be used in these methods.

The polypeptides of Invention II are not related to the antibodies of Invention III. They differ structurally and functionally, cannot be used together or interchangeably, and have non-coextensive searches and considerations.

The polypeptides of Invention II are distinct from the methods of Invention IV. They have other uses, such as the generation of antibodies.

The polypeptides of Invention II are not related to the antagonists of Invention V. They differ structurally and functionally, cannot be used together or interchangeably, and have non-coextensive searches and considerations.

The polypeptides of Invention II are not related to the methods of Invention VI. They cannot be used in these methods.

The antibodies of Invention III are distinct from the methods of Invention IV because they can be detected in other ways, such as by Western blotting, and the methods can be used to identify other antagonists.

The antibodies of Invention III are distinct from the antagonists of Invention V because the antagonists include other classes of compounds that are structurally unrelated to the antibodies.

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The antibodies of Invention III are distinct from the methods of Invention VI because they have other uses, such as protein purification.

The methods of Invention IV are distinct from the antagonists of Invention V because the antagonists may be identified in other ways.

The methods of Invention IV are not related to the methods of Invention VI. They have different method steps, require different reagents, and have different goals and outcome measures.

The antagonists of Invention V are distinct from the methods of Invention VI because they have other uses, such as functional studies.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the searches required for the different groups are different, restriction for examination purposes as indicated is proper.


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Andres whose telephone number is 703-305-0557. The examiner can normally be reached on M-F, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Janet L. Andres, Ph.D.
Patent Examiner
November 19, 2002